

## **REMARKS**

Claims 1-27, as amended, are pending in this application. In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claim 1 has been amended to avoid any 35 U.S.C. §112 issues. Independent claim 22 has also been amended to remove the period before the word “selected.” As no new matter has been added, Applicant respectfully requests entry of these amendments at this time.

## **THE REJECTIONS UNDER 35 U.S.C. § 103**

### ***The §103(a) Rejection of Independent Claim 1 Based on Lucas in View of Quine***

In the Office Action, claims 1-8, 11-12, and 26-27 were rejected under 35 U.S.C. §103(a) as being unpatentable by U.S. Patent Publication 2002/0143533 to Lucas (“Lucas”) in view of U.S. Patent No. 6,717,957 to Quine (“Quine”). Applicant submits that one skilled in the art would not be motivated to combine Lucas with Quine for the reasons that follow.

At Page 4, lines 1-6 of the Office Action, the Examiner acknowledges that Lucas does not disclose a document distribution module as claimed by the present invention. The Examiner cites the Quine reference as teaching this features. Specifically, the Examiner asserts that the Quine reference teaches a document distribution module that distributes at least one of a plurality of documents to at least one of a plurality of recipients based at least in part on a preference of the recipient.

The Lucas reference is directed to a method and apparatus for voice dictation and document production. The written description of the Lucas application is directed primarily to describing a method and apparatus for transcribing dictated notes. The stated goal of Lucas is to eliminate the need for traditional read-and-type or listen-and-type transcription. Accordingly, Lucas discloses a voice recognition engine that can transcribe dictated notes, which may then be stored in a memory.

On the other hand, the Quine reference is directed towards a closed-loop message distribution method directed primarily to applications where both senders and recipients are

employees of a single organization. The goal of the Quine reference is to prevent a recipient from receiving multiple communications related to a specific topic. This is achieved by using “response flags” for all recipients. Based on the response flags, the communications system disclosed by Quine is capable of suppressing further mailings to those recipients whose response flags indicate that they are no longer intended to receive a particular communication.

The Examiner has not identified any motivation to combine Lucas and Quine. Moreover, as described above, it is clear that one skilled in the art would not be motivated to combine the teachings of Lucas and Quine. Specifically, the two references are directed towards different technologies and achieve different outcomes. A skilled artisan would not be motivated to combine a voice transcription method and apparatus (Lucas) with an apparatus and method for preventing a user from receiving multiple related messages (Quine). In particular, the Lucas reference does not teach or suggest the ability to be combined with a closed loop messaging system, as described by Quine. Moreover, the Quine reference does not teach or suggest that it can be used with an apparatus for voice dictation and document production, as disclosed by Lucas.

For these reasons, Applicant respectfully submits that the §103(a) rejection of independent claim 1 has been overcome. Reconsideration and allowance are respectfully requested.

***The §103(a) Rejection of Independent Claim 16 Based on Lucas in View of Quine***

At page 8 of the Office Action, the Examiner rejected independent claim 16 under 35 U.S.C. §103(a) as being unpatentable over Lucas in view of Quine for the reasons stated with respect to the rejection of independent claim 1. However, as described above there is no motivation or suggestion to combine Lucas and Quine. Therefore, Applicant asserts that the rejection of claim 16 has been overcome. Reconsideration and allowance are respectfully requested.

***The §103(a) Rejection of Independent Claim 22 Based on Lucas in View of Quine***

At pages 8-9 of the Office Action, the Examiner rejected independent claim 22 under 35 U.S.C. §103(a) as being unpatentable over Lucas in view of Quine for the reasons stated with respect to the rejection of independent claims 1 and 16. However, as described above there is no motivation or suggestion to combine Lucas and Quine. Therefore, Applicant asserts that the

rejection of claim 22 has been overcome. Reconsideration and allowance are respectfully requested.

### ***The Dependent Claims***

In the Office Action, the Examiner rejected dependent claims 2-8, 11-12, and 26-27 under 35 U.S.C. §103(a) as being unpatentable over Lucas in view of Quine. In addition, the Examiner rejected dependent claims 9-10, and 23-25 under 35 U.S.C. §103(a) as being unpatentable over Lucas in view of U.S. Patent No. 5,978,755 to Podhradsky ("Podhradsky"). Applicant submits, however, that claims 2-12 and 23-27, at least by virtue of dependency from independent claims 1, 16, or 22, are in condition for allowance. Reconsideration and allowance are respectfully requested.


### **CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicant invites the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including February 9, 2005. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin LLP Deposit Account No. 195127, Order No. 25241.0004.

Respectfully submitted,  
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Dated: February 9, 2005

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